

DREIER

ATTORNEYS AT LAW

DOCUMENT

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DOC #:

DATE FILED: 11/20/07

The Gursky Group

Ira S. Sacks Partner
Direct 212 652 3730
isacks@dreierllp.com**MEMO ENDORSED****Via Facsimile**Honorable Colleen McMahon
United States Courthouse
500 Pearl Street, Room 640
New York, New York 10007Re: **Sanei Charlotte Ronson LLC v. GMA Accessories, Inc.**
07 CV 9578 (CM)

Dear Judge McMahon:

We are writing to you on behalf of Plaintiff Sanei Charlotte Ronson LLC ("Sanei") in response to GMA Accessories, Inc.'s ("GMA") letter to Your Honor of today's date. In its letter, GMA asks for a 10 day extension of time to answer or move with respect to the complaint and argues that this case is related to another case currently pending before Hon. Laura Taylor Swain under docket no. 07cv3219(LTS)(the "Solnicki Case"). Both of those points are distorted by GMA.

GMA's Extension Request

In its letter, GMA falsely asserts that "[d]uring the past week or so we have attempted to persuade counsel for SANEI to agree ... to a brief extension but SANEI has refused." First, Sanei has never refused GMA's request for an extension of time to move or otherwise respond to the complaint. To the contrary, when Mr. Sweeney (one of GMA's counsel) contacted our office last Wednesday to request an extension, Rob Grand, a partner at Dreier LLP, informed him that we would need to ask the client. Thereafter, Mr. Sweeney faxed Mr. Grand a proposed stipulation (without getting our approval for the extension). A true and correct copy of Mr. Sweeney's proposed stipulation is attached hereto as Exhibit A. Mr. Grand faxed a letter back to Mr. Sweeney with a revised stipulation, agreeing to the extension if GMA agreed to participate in a Rule 26(f) conference - as contemplated by your Honor's Scheduling Order - by the end of last week. A true and correct copy of the letter from Mr. Grand is attached hereto as Exhibit B.

We added that Rule 26(f) condition because this Court's November 2, 2007 Order Scheduling Initial Pretrial Conference requires that the parties confer, complete and sign

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Los Angeles Stamford Albany
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GMA's request for leave
to move a answer is granted
2) However, that has
NOTHING TO DO
with the Rule 26 conference
or with the obligation to meet
and confer. You WILL meet and
confer and you WILL either
agree to a
discovery

Schedule or you
will meet
with me.
I do
not
postpone Rule 26
conferences.

Colleen
McMahon
USDS
PS - I
dispute of
motion
&
dismiss
reilly
at
Rule 26
Conference.

Honorable Colleen McMahon
November 19, 2007
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a Civil Case Management Plan within thirty (30) days of November 2, 2007, and GMA had ignored all of our requests to confer. We also understood from the November 2, 2007 Order that a Civil Case Management Plan was required even if Defendant moved to dismiss. (We note that such a motion – which GMA has indicated it intends to make – will be largely frivolous.)

After failing to get a response to our proposed stipulation, on November 15, 2007, our office sent an email to GMA's counsel asking if they were available to participate in a Rule 26(f) conference at 3 p.m. on November 16, 2007. A true and correct copy of that email is attached hereto as Exhibit C. In response, Mr. Sweeney sent an email stating that GMA is "currently attempting to determine the issues presented in your pleading so that we may be in a position to answer it, frame discovery if need be or file a motion to dismiss etc." A true and correct copy of Mr. Sweeney's response is attached hereto as Exhibit D.

GMA again failed to respond to Sanei's request for a Rule 26(f) conference and failed to contact us regarding the revised stipulation until 6:30 p.m. on Friday, November 16, 2007, at which time Mr. Sweeney left a message for Mr. Grand again requesting an extension. Mr. Grand did not get this message until Monday, November 19, 2007. On Monday, November 19, 2007, Mr. Grand again explained to GMA's counsel that we would consent to the extension if they would agree to a proposed Civil Case Management Plan. Thereafter, we emailed a proposed Civil Case Management Plan to GMA's counsel, but instead of receiving a response to our email, we received the letter which was sent to Your Honor.

Sanei does not object to a 10 day extension of GMA's time to answer or move and Sanei has never refused such an extension. Instead, Sanei merely wanted GMA to participate in the Rule 26(f) conference and comply with Your Honor's November 2 Order regarding the Civil Case Management Plan before agreeing to such an extension.

The Solnicki Case and The Sanei Case Are Not Related

GMA's counsel also falsely states that it has "attempted to persuade counsel for SANEI to agree that the cases are related..." As GMA's counsel is well aware, I told Mr. Sweeney that these cases are not related; however, GMA's counsel has never attempted to persuade me that these cases are related. In our view the two cases are unrelated. The Solnicki case relates to the use of the CHARLOTTE SOLNICKI trademark on goods marketed under that mark, while this case relates to the use of the CHARLOTTE RONSON trademark on goods marketed under that mark. The controlling facts relating to these cases are different.

The key issue in both cases will be likelihood of confusion. In evaluating whether there is a likelihood of confusion between two marks, courts apply the multi-factor "Polaroid test" set forth by Judge Friendly in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961). The *Polaroid* test calls

Honorable Colleen McMahon

November 19, 2007

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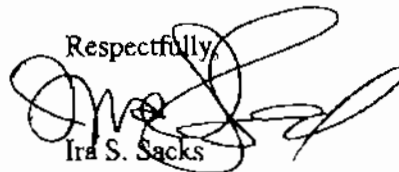
for the balancing of the following non-exhaustive list of factors: i) the strength of the plaintiff's mark; ii) the degree of similarity between the two marks; iii) the proximity of the products; iv) the likelihood that the plaintiff will bridge the gap; v) actual confusion; vi) sophistication of the consumers; vii) bad faith; and viii) the quality of the defendant's products. *Polaroid Corp.*, 287 F.2d at 495. Virtually all of those factors – factors (ii), (iii), (iv), (v), (vi), (vii) and (viii) – are different for the two cases. That is because the marks are different, the products marketed under the marks are different, and facts relating to alleged actual confusion and alleged bad faith are different. Thus, the *Polaroid* analysis will be different in each case.

Indeed, there is a third case – *Jimlar Corp. v. GMA*, 07 Civ. 8622 – involving Charlotte branded product sold by Plaintiff Jimlar Corp. – pending before Judge Stein where GMA has merely answered and counterclaimed. That case is not related to either of the other two for the same reasons – its determination will turn on facts almost entirely different from the other two cases.

Thus, although this firm represents certain defendants in the Solnicki Case and represents Sanei in this case, the two cases are not related and should not be treated as such.

As a result, we respectfully request that GMA's request for an extension be denied unless it agrees to participate in a Rule 26(f) conference forthwith.

Respectfully,



Ira S. Sacks

cc: John Bostany (via Facsimile)

EXHIBIT A

40 Wall Street, 61st Floor, New York NY 10005
Tel: (212) 530-4400, Fax: (212) 530-4488

The Bostany Law Firm

Fax

To: Robert Grand, Esq.

From: Andrew T. Sweeney, Esq.

Fax: 212-328-6101

Pages: 2

Phone: 212-328-6118

Date: November 13, 2007

Here is the proposed stipulation I discussed with you.

Also tomorrow's deposition of Showroom Seven Studios, Inc. has been postponed to the week of November 28.

Regards,



UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

SANEI CHARLOTTE RONSON LLC,

Plaintiff,

STIPULATION

Civil Action No.: 07CV9578 (CM)

- against -

GMA ACCESSORIES, INC.,

Defendants.

It is hereby stipulated and agreed by and between the parties hereto that defendant has until November 30, 2007 to answer or move with respect to the complaint filed on October 26, 2007.

Dated: November 13, 2007

Robert Grand, Esq.
Drier, LLP
Attorney for Plaintiff
SANEI CHARLOTTE RONSON LLC
499 Park Avenue
New York, NY 10022

Andrew T. Sweeney (AS 0724)
The Bostany Law Firm
Attorney for Defendant
GMA ACCESSORIES, INC.
40 Wall Street, 61st Floor
New York, NY 10005

EXHIBIT B

DREIER^{LLP}

ATTORNEYS AT LAW

Robert J. Grand Partner
Direct 212 328 6118
rgrand@dreierllp.com

November 14, 2007

VIA FAX (212) 530-4488

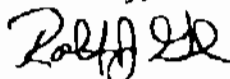
Andrew T. Sweeney
The Bostany Law Firm
40 Wall Street - 61st Floor
New York, NY 10005

Re: *Sanei Charlotte Ronson LLC v. GMA Accessories, Inc.*, 07CV9578(CM)

Dear Mr. Sweeney:

I received your fax dated November 13, 2007, along with your draft stipulation. Although your draft stipulation does not accurately reflect our discussion on the matter, our client will nevertheless agree to grant your client the requested extension of time to Answer or move with respect to the complaint in accordance with the terms set forth in the Stipulation attached hereto, which I believe more accurately reflects our telephone conversation yesterday.

Sincerely,



Robert J. Grand

cc: Lisa T. Simpson, Esq.

Ira S. Sacks
Robert J. Grand
Mary L. Grieco
Safia A. Anand
DREIER LLP
499 Park Avenue
New York, NY 10022
(212) 328-6100

Lisa T. Simpson
ORRICK, HERRINGTON & SUTCLIFFE LLP
666 5th Avenue
New York, NY 10103
(212) 506-5100

Attorneys for Plaintiff

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----X
SANEI CHARLOTTE RONSON LLC,

Plaintiff,

-against-

GMA ACCESSORIES, INC.,

Defendant.
-----X

Civil Action No.:
07 CV 9578 (CM)

STIPULATION

It is hereby stipulated and agreed by and between the parties hereto that the time for Defendant to answer or move with respect to the Complaint is extended through and including November 30, 2007, on the condition that Defendant complies with the Court's November 2, 2007 Order that the parties "confer, complete and sign" the Civil Case

Management Plan on or before November 16, 2007.

Dated: November 14, 2007

Robert J. Grand
Dreier LLP
499 Park Avenue
New York, New York 10022
(212) 328-6100

Attorneys for Plaintiff
Sanei Charlotte Ronson LLC

Andrew T. Sweeney
The Bostany Law Firm
40 Wall Street, 61st Floor
New York, New York 10005
(212) 530-4400

Attorneys for Defendant
GMA Accessories, Inc.

EXHIBIT C

Safia Anand

From: Safia Anand
Sent: Thursday, November 15, 2007 1:07 PM
To: 'Andrew.Sweeney@bozlaw.com'; 'John Bostany'
Cc: Mary Grieco; Ira S. Sacks; Robert Grand
Subject: Ronson/GMA
Importance: High

As a follow-up to the stipulation that Rob Grand sent you yesterday in the Ronson/GMA matter, please let us know if you are available for a Rule 26(f) conference tomorrow at 3:00 pm. If so, we will call you. We look forward to hearing from you soon.

Very truly yours,

Safia

Safia A. Anand
Associate

DREIER ^{LLP}

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Direct: (212) 652-3773
Fax: (212) 328-6101
sanand@dreierllp.com

11/19/2007

EXHIBIT D

Safia Anand

From: Andrew Sweeney [Andrew.Sweeney@bozlaw.com]
Sent: Thursday, November 15, 2007 4:21 PM
To: Robert Grand
Cc: Mary Grieco; Ira S. Sacks; Safia Anand; john@bozlaw.com
Subject: RE: Ronson/GMA

Mr. Grand:

We are currently attempting to determine the issues presented in your pleading so that we may be in a position to answer it, frame discovery if need be or file a motion to dismiss etc.

Please advise why you checked "no" to the question on the civil cover sheet, whether a similar case is pending, when much of your claim is related to the SOLNICKI case pending before Judge Swain where you represent most of the defendants.

ATS

From: Safia Anand [mailto:sanand@dreierllp.com]
Sent: Thursday, November 15, 2007 1:07 PM
To: Andrew.Sweeney@bozlaw.com; John Bostany
Cc: Mary Grieco; Ira S. Sacks; Robert Grand
Subject: Ronson/GMA
Importance: High

As a follow-up to the stipulation that Rob Grand sent you yesterday in the Ronson/GMA matter, please let us know if you are available for a Rule 26(f) conference tomorrow at 3:00 pm. If so, we will call you. We look forward to hearing from you soon.

Very truly yours,

Safia

Safia A. Anand
Associate

DREIER LLP
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FAX COVER SHEET

Date: November 19, 2007

NAME	COMPANY	FAX NO.	TEL. NO.
Honorable Colleen McMahon	US Courthouse	(212) 805-6326	
John Bostany	The Bostany Law Firm	(212) 530-4413	

FROM: Ira S. Sacks
DIRECT DIAL: (212) 328-6100
RE: Sanei Charlotte Ronson LLC v. GMA Accessories, Inc.
07 CV 9578 (CM)

Message:**Please see attached.****Thank you.**No. of Pages (including cover sheet): 16

If you have any difficulties receiving this transmission, please call (212) 328-6100

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THE BOSTANY LAW FIRM

40 WALL STREET

4/2007

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NEW JERSEY OFFICE

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NEWARK, NJ 07102

November 19, 2007

Hon. Colleen McMahon
United States District Judge
Southern District of New York
500 Pearl Street
New York, NY 10007

Re: *Sanei Charlotte Ronson LLC v. GMA Accessories, Inc.*,
Docket No.: 07 CV 9578 (CM)


Your Honor:

We represent the defendant GMA Accessories, Inc. (hereinafter "GMA") in this matter and respectfully request a 10 day extension of time from today's deadline to answer or move with respect to the complaint herein. The dispute concerns the mark CHARLOTTE that has been owned by my client for many years with respect to clothing, handbags and other goods. The Plaintiff here, SANEI, is also an applicant for the mark CHARLOTTE RONSON in the USPTO. A good portion of the instant action accuses GMA of enforcing its mark in bad faith by way of companion litigation pending in this Court before Hon. Laura Taylor Swain under docket no. 07cv3219 (LTS) (there Judge Swain is deciding whether to enjoin use of CHARLOTTE SOLNICKI and issued a decision with respect to some of the defendants there which can be found at 507 F.Supp.2d 361).

Although SANEI's law firm (Dreier, LLP) also represents several of the defendants in the SOLNICKI case, the issues appear to be the same, many of the claims contained in the instant action are duplicates of counterclaims that the Dreier firm cast in the SOLNICKI case, and SANEI makes specific reference to the Solnicki case repeatedly throughout its pleading. SANEI declined to mark it as a related case on the civil cover sheet. During the past week or so we have attempted to persuade counsel for SANEI to agree that the cases are related and to agree to a brief extension but SANEI has refused.

Wherefore, we respectfully ask for an extension until November 30 to answer or move with respect to the complaint.

Respectfully,


Andrew T. Sweeney

cc: Robert J. Grand, Esq.